

REMARKS

Claims 1-8 and 12-77 are pending in the present application. Claims 1, 25 and 30-37 are independent.

The undersigned attorney would like to again thank Examiner Warden for her time during the August 8, 2005 telephone call. During that call the undersigned attorney explained that each pending independent claim recites a "handheld pipette" and that a pipette is operable for aspirating and dispensing fluid. Applicants have amended the preambles of independent claims 25 and 32-37 to further define their respective scope by adding "operable for aspirating and dispensing fluid". The remaining independent claims (claims 1, 30 and 31) already include a recitation that the pipette aspirates and dispenses fluid and therefore have not been amended herein.

In the outstanding Office Action, claim 16 was objected to because the word "surgace" should be --surface--. Accordingly, Applicants have amended claim 16 by changing "surgace" to --surface-- and therefore request that the objection be withdrawn.

Claim 17 was rejected under 35 U.S.C. 112, second paragraph, because it is unclear if applicant is attempting to claim the tip as a portion of the invention and the tip is not positively claimed as an element of the invention. Claim 17 recites a "handheld pipette". The handheld pipette includes a nozzle (positively claimed) that is operable for receiving a pipette tip. Applicants have amended the claims accordingly and request that the rejection be withdrawn.

Claims 1, 2, 4, 12, 13, 15-18, 21-24, 30-32, 38, 40, 45, 46, 48, 49, 51, 54-58, 60, 65, 66, 68, 69, 71 and 74-77 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. Appl. Publ. No. 2001/0035429 ("Colquhoun"). Claims 1, 2, 4, 12, 13, 15-18, 21-24, 30-32, 38, 40, 45, 46, 48, 49, 51, 54-58, 60, 65, 66, 68, 69, 71 and 74-77 were rejected under 35 U.S.C.

102(e) as being anticipated by U.S. Pat. No. 6,105,819 ("Ho et al."). Claims 1, 2, 4, 6-8, 12, 13, 15-19, 21-36, 38, 40, 42-46, 48, 49, 51, 52, 54-58, 60, 62-66, 68, 69, 71, 72 and 74-77 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,796,204 ("Math"). Claims 1-6, 8, 12, 13, 15-18, 21-25, , 28, 30-35, 38-42, 44-46, 48-51, 54-62, 64-66, 68-71 and 74-77 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,086,348 ("Bernhardt").

Independent claims 1, 25 and 30-37 were rejected as being anticipated by Colquhoun, Ho et al., Math and/or Bernhardt.

Colquhoun and Ho et al. relate to dispensing containers, Math relates to a dispenser cap for dispensing containers and Bernhardt relates to a spraying or pump apparatus. Each of these references describes and illustrates containers that are only operable for dispensing (or pumping) the contents out of the respective container.

Independent claims 1, 30 and 31 recite that the "at least one button located on the top of the body portion" is "operable by a thumb of the operator to effect aspiration and dispensing of fluid through said nozzle portion". Independent claims 25 and 32-37 recite "handheld pipette operable for aspirating and dispensing fluid". Neither Colquhoun, Ho et al., Math nor Bernhardt teach or suggest aspiration of fluid into a container. This lack of teaching or suggestion is expected as a dispensing container (or pump) dispenses/removes fluid from a container. The dispensing containers (or pumps) taught in Colquhoun, Ho et al., Math and Bernhardt are not structurally capable of aspirating fluid into the containers.

Accordingly, Applicants respectfully request that the rejection of independent claims 1, 25 and 30-37 be withdrawn. Also, Applicants respectfully request that the rejection of those

claims depending from and furthering limiting independent claims 1, 25 and 30-37 be withdrawn.

Additionally, Applicants respectfully traverse the rejections of independent claims 32-37 for at least the following reasons.

Regarding independent claim 32, Applicants note that the Office Action did not address the element "said nozzle angle  $\theta$  is adjustable". Applicants respectfully submit that Colquhoun, Ho et al., Math and Bernhardt do not describe or suggest a handheld pipette including an adjustable nozzle angle. Rather, the pump spouts are fixed.

Regarding independent claims 33-35, Applicants respectfully submit that neither Math nor Bernhardt teach or suggest a handheld pipette including "a hook extending from a point on said body portion which is sufficiently angularly spaced from the point from which said nozzle extends to permit the hook to fit over a selected portion of the operator's hand when the pipette is being held by the operator in a position of use". Further, claim 34 recites "said hook is adjustable" and claim 35 recites "said hook is removably mounted to said body portion, said hook being replaceable with a hook of different size/shape to accommodate at least one of user preference and different hand sizes".

Regarding independent claim 36, Applicants respectfully submit that Math does not teach or suggest a handheld pipette including "an adapter selectively mountable to said body portion, said adapter adjusting the size of said body portion to better fit operator hand size".

Claims 14, 47 and 67 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bernhardt in view of U.S. Pat. No. 6,737,023 ("Kelly et al."). Claims 20, 37, 53 and 73 were rejected under 35 U.S.C. 103(a) as being unpatentable over Colquhoun, Ho et al., Math or Bernhardt in view of U.S. Pat. No. 5,983,733 ("Strandberg et al.").

Claims 14, 47 and 67, and claims 20, 53 and 73 depend from and further limit claims 1, 30 or 31, and, for at least the reasons stated above in connection with claim 1, 30 and 31 are patentable over the cited references.

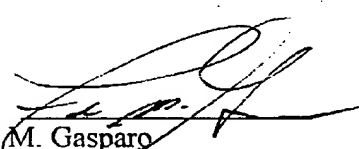
Regarding independent claim 37, neither Colquhoun, Ho et al., Math, Bernhardt nor Strandberg et al. teach or suggest a handheld pipette including "a nozzle portion extending from a point on said body portion and at a downward angle  $\theta$  of approximately  $60^\circ$  to  $80^\circ$  to a central axis of said body portion". Rather, Strandberg et al. describes an axial pipette and as set forth above Colquhoun, Ho et al., Math, Bernhardt and Strandberg et al. describe dispensing containers.

This communication is believed to be fully responsive to the Office Action and every effort has been made to place the application in condition for allowance. The claims, in view of the foregoing explanation, are believed to be patentable over the cited art, and a favorable Office Action is hereby earnestly solicited.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Examiner is requested to telephone the number provided below.

Respectfully submitted,

Date: August 17, 2005

By:   
Frank M. Gasparo  
Registration No. 44,700  
Baker & McKenzie LLP  
805 Third Avenue  
New York, NY 10022  
Telephone (212) 751-5700  
Facsimile (212) 759-9133